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### REMARKS

Entry of this Amendment is proper under 37 CFR §1.116, since no new claims or issues are presented.

More important, a potential cloud on the prosecution has been caused by the Examiner and generated by the Office Action mailed on March 21, 2006, by the denial therein of the recently-filed Rule 131 Declaration. Applicant suggests that the Examiner might want to use this opportunity to clarify his position on the record, thereby possibly averting the necessity for Applicant to file a Petition Under 37 CFR 1.181, requesting clarification of the official legal position of the USPTO relative to this denial, prior to making any additional steps that might be necessary to clear up this potential cloud on the prosecution.

Claims 20-31 and 38 are all the claims currently pending. Claims 32-37 and 39 are canceled above. Claims 20-25 have been amended to convert them from "method" claims to "system" claims.

It is noted that Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 20-38 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Siemens TdocN4-000476, further in view of US Patent Publication US 2003/0032440 to Sato et al. Claims 20, 26, 32, 38, and 30 stand rejected under 35 U.S.C. § 103(a) as unpatentable over US Patent No 5,608,779 to Lev et al., further in view of Sato.

These rejections are traversed in the discussion below.

#### **I. THE CLAIMED INVENTION**

As described in the specification and defined exemplarily in independent claim 20, the present invention is directed to a communications system including a first switching means for inserting and removing a first transcoder in the first switching means. A second switching means selectively inserts and removes a second transponder in the second switching means.

A first radio network controlling means controls a first radio network, the first radio

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network controlling means belonging to the first switching means. A second radio network controlling means controls a second radio network, the second radio network controlling means belonging to the second switching means.

The second transcoder is inserted in the second switching means after a mobile terminal in the first radio network is moved to the second radio network, and the second switching means inquires of the second radio network controlling means about whether compression coding information on a side of the mobile terminal can be changed so that the second transcoder can be bypassed. The second switching means removes the second transcoder if the compression coding information is successfully changed.

As explained in lines 16-19 on page 5, the conventional method for inserting at least four coding/decoding devices causes degradation of tone quality.

Moreover, as discussed beginning at line 20 on page 5, although the method based on Siemens TdocN4-00476, cited by the Examiner in the rejection currently of record, inserts a transcoder to get RFCI information, when RFCI information turns out to be different, a re-initialization is required.

The claimed invention, on the other hand, takes the approach of making an inquiry as to whether compression coding information can be changed. If the coding is successfully changed, the transcoder is then removed.

## II. THE DENIAL OF THE RULE 131 DECLARATION

In the Amendment Under 37 CFR § 1.111, filed on December 28, 2005, Applicant included therein a Declaration Under Rule 37 CFR §1.131 for purpose of swearing behind newly-cited Siemens TdocN4-000868.

In paragraph 3 on page 7 of the Office Action mailed on March 21, 2006, the Examiner states that the Rule 131 Declaration was "... *ineffective to establish a conception date of 28 August 2000 since there is no proof that Mr. Tamura shown in Exhibit 2 is the inventor of Exhibit 1 (e.g. a physics professor who teaches the law of gravity may not be the one who discovered the law of gravity)*".

However, in seeming contradiction to this assertion of ineffectiveness, the Examiner

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then dropped the disputed reference as a prior art reference in a formal rejection without further explanation, thereby clearly contradicting the position that the Rule 131 Declaration was somehow deficient and further confusing the intent of the denial.

It is noted that, in all his years practicing patent law, Applicant's representative has never had a Rule 131 Declaration challenged, let alone denied. In attempting to get an explanation for the denial from the Examiner's Supervisor, the Examiner's Special Programs Examiner, and the Examiner himself, it was discovered that there is considerable confusion in this art unit concerning the legal significance of a Rule 131 Declaration.

As best understood, the Examiner's denial is based upon the wording "... was known to me ...." in the second line of paragraph 2 of the Declaration. As best understood, the Examiner attempts to interpret this wording as indicating that perhaps the Applicant was actually describing himself as possibly not being the inventor, thereby providing the USPTO the opportunity to take these words out of the context of the remainder of the document and to presumably allege that Applicant has committed perjury.

In response, Applicant's representative submits that this attempt to isolate wording in a Rule 131 Declaration and interpret the isolated wording outside the context of the four corners of the document is error as a matter of law. The Declarant has sworn in the preceding paragraph 1) and the final paragraph of the document that he believes himself to be the true inventor. The Applicant has also made such sworn statement in the Declaration and Power of Attorney filed on August 24, 2001, with the filing of the present application.

Although these Examiners may have personal preferences for alternate wording on legal documents such as a Rule 131 Declaration, the Examiners have overreached by rejecting such documents merely because of personal wording preferences. The purpose of the Rule 131 Declaration is merely that of serving as a vehicle to present facts relevant to establish invention prior to a cited prior art reference. The Examiners may or may not want to make of record concern with specific phraseology within these legal documents, but making of record concern over specific phraseology is entirely different from that of refusing to recognize that the facts presented by the document would indeed swear behind the cited reference.

In the present case, the Declaration was used to present a copy of the materials presented by the Declarant at a technical meeting in Seattle. A website at which all material

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presented at that meeting was also listed in the Declaration, so that the Examiner could verify this document's source and could recognize that the author's name as missing from this copy because none of the other materials presented at that meeting likewise had any authorship identified on the documents. Declarant also provided a copy of the email used to initially distribute the materials to those expected to attend this technical conference in Seattle.

The Examiner's role for a Rule 131 Declaration is that of evaluating whether the facts presented adequately support the Declarant's position that he had completed the invention prior to a specific date and, possibly, if there is some objective deficiency in the documents presented, whether there is any reason to doubt the veracity of any of the evidence presented. The Examiner's role is not that of judging whether the choice of wording in the Declaration itself satisfies the personal preference of the Examiner.

Stated slightly differently, the wording in a Rule 131 Declaration is not subject to the broad interpretation expected during prosecution for claim language and is not subject to be interpreted outside the context of the remaining wording of the document.

All three of the Examiners contacted by Applicant's representative seemed genuinely unaware that the denial of this Rule 131 by simply ignoring the other wording, particularly the sworn statement by the Declarant that he believes himself as the true inventor, constitutes an allegation by the USPTO of perjury by the Declarant.

Accordingly, because of this immensely legal significance, Applicant requests that the Examiner provide a very clear explanation on the record of his position in the previous rejection, if it is to be maintained, so that Applicant can begin the process of taking appropriate legal actions to clear up this cloud on the prosecution.

### III. THE PRIOR ART REJECTIONS

The Examiner alleges that Siemens TdocN4-000476, when modified by Sato, renders obvious claims 20-38 and that Lev, when modified by Sato, renders obvious claims 20, 26, 32, 38, and 30. Applicant submits, however, that there are elements of the claimed invention which are neither taught nor suggested by Siemens or Lev, even if modified by Sato.

Applicant first points out that Sato is not properly documented as qualifying as a prior

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art reference against the present invention, since the US filing date is later than the Japanese priority date of December 13, 2000, for the present Application. As best understood, the Office has the burden to establish the PCT date as applicable by demonstrating that the original PCT filing designated the US and that an English version was published within the defined time period, understood as being 18 months. The file history available on PAIR for Sato does not provide sufficient information to support such requirements, and Applicant requests that the Office provide an analysis on the record that Sato properly qualifies as a prior art reference.

Second, and more significant, in a key feature of the present invention as defined by the independent claims, the switching node inquires of the second RNC about whether compression coding information of a side of said mobile terminal can be changed so that said transcoder can be bypassed. If the compression coding information is successfully changed, the transcoder is removed.

The prior art of record fails to make such inquiry.

Relative to the rejection based upon Siemens '476, the Examiner attempts to rely upon Figure 6 therein as demonstrating this inquiry. However, this lack of an inquiry in Siemens '476 is clearly demonstrated by the description in step 11 related to Figure 6: *"If the RFCI mapping from RNC-A' doesn't match to the one from RNC-A, re-initialisation (without suspending UP activities, as described in 25.415) will be necessary."* That is, clearly Siemens '476 fails to make the inquiry as taught in the present invention, since this description clearly indicates that its method does not know whether the RFCI mapping matches.

Hence, turning to the clear language of the claims, in Siemens '476 there is no teaching or suggestion of: "... said second switching means inquires of said second radio network controlling means about whether compression coding information on a side of said mobile terminal can be changed so that said second transcoder can be bypassed and removes said second transcoder if said compression coding information is successfully changed", as required by claim 20. The remaining independent claims have similar language.

More specifically, concerning the claim language, the "switching node", which is supported by "MSC" in Figure 5, inquires of "said second RNC", which is supported by

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"NEW RNC" in Figure 5, and lines 1-3 on page 14 of the specification. Also, "said second RNC" sends "ACK" to the "switching node" in response to the inquiry ("ACK" in Figure 5 of the present Application, and lines 5-9 of page 14).

In contrast, neither Siemens nor Lev teach or suggest this aspect of the claimed invention of making an inquiry.

Making the comparisons between Siemens and the claimed invention, the previous version of claim 20, involving the definition of the method, read:

*A method used in a switching node for communications between said switching node and a mobile terminal, said method comprising: <B> inserting a transcoder in said switching node <A> after said mobile terminal in a first area covered by a first radio network controller (RNC) is moved to a second area covered by a second RNC; <F> inquiring of said second RNC about whether compression coding information on a side of said mobile terminal can be changed so that said transcoder can be bypassed; and <H> removing said transcoder <G> if said compression coding information is successfully changed.*

To compare the method of the present invention, as described in the above version of claim 20, with the method shown Siemens '476, the following page provides a marked up version of Figure 5 of the present Application and Figure 6 from Siemens '476, with possible correspondence to the claim language indicated above.

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Declaraciones de los autores: Los autores declaran que no existe conflicto de intereses.

1. **APC A certain Recommendation Required**

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According to Siemens, for instance, "RNC-A", which corresponds to "said second RNC" of the claimed invention, initializes MGW-A, which corresponds to the "switching node" of the present invention (see "10. INIT" in Figure 6 of Siemens). Also, MGW-A sends "12. INIT ACK or MODEIND (RFCI map-A)" to RNC-A in response to "10. INIT".

When a "switching node" such as an MSC inquires "of said second RNC" about whether compression coding information on a side of said mobile terminal can be changed so that said transcoder can be bypassed", it can switch to a transcoder-free mode with a high possibility, because it has known compression coding information so far. Therefore, the present invention decreases a probability that it has to re-initialize again and again, as shown in Page 8 of Siemens ("If the RFCI mapping from RNC-A doesn't match to the one from RNC-A, re-initialization will be necessary.")

This explanation is also applicable to the independent claims as revised in the claim amendments above. The difference between the present invention and Siemens is also described in line 20 of page 5 through line 11 of page 6 of the present specification.

Therefore, since the rejection relies upon secondary reference Sato for reasons unrelated to this inquiry, claims 20-38 are clearly patentable over Siemens.

Relative to the rejection based upon Lev, the description of this primary reference about determining that the requested call is mobile-to-mobile may be a fair characterization of Lev, but it fails to satisfy the plain meaning of the claim language of the independent claims as amended above, and the present invention is clearly patentable over Lev.

Therefore, Applicant submits that there are elements of the claimed invention that are not taught or suggest by Siemens '476, Lev, or Sato. Therefore, the Examiner is respectfully requested to withdraw this rejection.

#### IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 20-31 and 38, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance,



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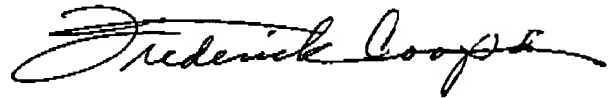
the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date:

7/21/06



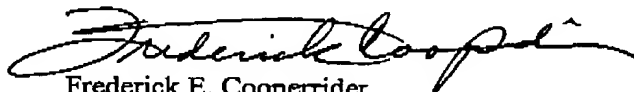
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CERTIFICATION OF TRANSMISSION

I certify that I transmitted via facsimile to (571) 273-8300 this Amendment under 37 CFR §1.116 to Examiner S. Sing on July 21, 2006.



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